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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BARQADLE, YASIN M

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/774,439

Applicant(s)

PATEL ET AL.

Examiner

Yasin M Barqadle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 05/13/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Amendment

1. The amendment filed on July 27, 2004 has been fully considered but are not deemed to be persuasive.

Response to Amendment

In response to applicant's arguments on page 10, paragraph 1 and page 11 paragraphs 3-5, that Donaldson fails to ^{teach} elements of claim 1 such as "checking for an open relay in routing information of a header of the electronic mail message."

Examiner notes that Donaldson teaches checking for an open relay in routing information based on the characteristics of the received SMTP protocol fields and the configuration of the remote host [col. 8, lines 10-29]. SMTP protocol fields include message header containing routing information as shown in fig. 3 of the SMTP message transfer. Donaldson defines conventional Message header in SMTP messages col. 32, lines 50-65].

Applicant argues on pages 10, paragraph 3-4 that elements in dependent claim 4, such as "biting harvest of an e-mail address corresponding the electronic mail message." is not anticipated by Donaldson. Examiner notes that Donaldson uses active filtering mechanism to identify email address corresponding to mail messages received from likely sources of spammer or junk email sender. Incoming emails are filtered actively to determine

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the source of the Junk email (col. 37-41). Furthermore, Donaldson determines the likely spammer's email address from configuration databases such as Blacklist DB 1095 which identifies Blacklisted IP address of remote hosts (col. 11, lines 17-65).

Applicant argues that Donaldson's probing test do not determine the facilitating part from the routing information of the header of a message. Examiner as explained above contends that SMTP protocol fields include message header containing routing information as shown in fig. 3 of the SMTP message transfer. Therefore, one must use the header information contained in routing information of the SMTP protocol.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual

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Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-9, 11 and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Donaldson USPN (6321267).

As per claim 1, Donaldson teaches a method for automatically detecting unsolicited electronic mail from a mailer (abstract) and automatically notifying facilitators of the mailer of the unsolicited electronic mail (col. 5, lines 1-11), the method comprising:

- receiving an electronic mail message from the mailer [incoming messages form a remote host are received and filtered col. 8, lines 1-18];

- automatically determining the electronic mail message is probably unsolicited filtered [col. 8, lines 1-29];

- checking for an open relay in routing information of a header of the electronic mail message [col. 8, lines 1-29];

- determining a facilitating party of the mailer [col. 15, lines 7-40]; and

- automatically reporting information relating to the electronic mail message to the facilitating party [complaints are made to mailer's ISP col. 5, lines 1-11 and col. 15, lines 7-40].

As per claim 2, Donaldson teaches the method for automatically detecting unsolicited electronic mail from the mailer and automatically notifying facilitators of the mailer of the unsolicited electronic mail as recited in claim 1, wherein the facilitating party comprises at **least one** of the following:

a first internet service provider (ISP) associated with an origin of the message [col. 5, lines 1-11 and col. 15, lines 7-40], an upstream provider for the first ISP, a second ISP associated with the reply address, a third ISP associated with an e-mail address in a body of the electronic mail message, a host of a web site referenced in the body of the electronic mail message, and the open relay in the routing information [col. 8, lines 1-29].

As per claim 3, Donaldson teaches the method for automatically detecting unsolicited electronic mail from the mailer and automatically notifying facilitators of the mailer of the unsolicited electronic mail as recited in claim 1, determining the electronic mail message is unsolicited based upon receipt of the electronic mail message [col. 8, lines 1-29 and col. 11, lines 37-54].

As per claim 4, Donaldson teaches the method for automatically detecting unsolicited electronic mail from the mailer and

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automatically notifying facilitators of the mailer of the unsolicited electronic mail as recited in claim 1, further comprising baiting harvest of an electronic mail address corresponding the electronic mail message [col. 11, lines 17-54 and col. 15, lines 41 to col. 16, line 11].

As per claim 5, Donaldson teaches the method for automatically detecting unsolicited electronic mail from the mailer and automatically notifying facilitators of the mailer of the unsolicited electronic mail as recited in claim 4, wherein the baiting the harvest comprises at **least one** of:

embedding the electronic mail address in a web page, applying for an account with a web site using the electronic mail address, participating in an online auction with the electronic mail address, posting to a newsgroup or message board with the electronic mail address, and posting to a public forum with the electronic mail address [col. 4, lines 50-58].

As per claim 6, Donaldson teaches the method for automatically detecting unsolicited electronic mail from the mailer and automatically notifying facilitators of the mailer of the unsolicited electronic mail as recited in claim 1, wherein the determining the facilitating party comprises determining at a protocol level which Internet protocol (IP) address sent the

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electronic mail message to the open relay [col. 8, lines 56-67 and col. 11, lines 18-44].

As per claim 7, Donaldson teaches the method for automatically detecting unsolicited electronic mail from the mailer and automatically notifying facilitators of the mailer of the unsolicited electronic mail as recited in claim 1, further comprising:

- determining an address of the mailer [col. 8, lines 56-67 and col. 11, lines 18-44]; and

- blocking electronic mail messages from the address for a predetermined period of time [col. 11, lines 18-44].

As per claim 8, Donaldson teaches the method for automatically detecting unsolicited electronic mail from the mailer and automatically notifying facilitators of the mailer of the unsolicited electronic mail as recited in claim 1, wherein the automatically reporting information comprises sending a report comprising information on a plurality of electronic mail messages [complaint is made to mailer's ISP col. 5, lines 1-11 and col. 15, lines 7-40].

As per claim 9, Donaldson teaches the method for automatically detecting unsolicited electronic mail from the mailer and automatically notifying facilitators of the mailer of the unsolicited electronic mail as recited in claim 1, wherein the

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automatically reporting information comprises periodically sending a report to the facilitating party [complaints are made to mailer's ISP col. 5, lines 1-11 and col. 15, lines 7-40].

As per claim 11, Donaldson teaches a method for automatically detecting unsolicited electronic mail from a mailer and automatically notifying facilitators of the mailer of the unsolicited electronic mail, the method comprising:

- receiving an electronic mail message from the mailer [incoming messages from a remote host are received and filtered col. 8, lines 1-18];

- determining the electronic mail message is unsolicited by comparing codes [col. 7, lines 31 to col. 8, line 29 and col. 15, lines 57-65];

- checking for a source address in routing information of a header of the electronic mail message [col. 11, lines 17-54 and col. 14, lines 6-19];

- determining a facilitating party of the mailer associated with the source address [col. 14, lines 6-19 and col. 15, lines 7-40]; and

- automatically reporting information relating to the electronic mail message to the facilitating party [complaint is made to mailer's ISP col. 5, lines 1-11), and col. 15, lines 7-40].

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As per claim 13, Donaldson teaches the method for automatically detecting unsolicited electronic mail from the mailer and automatically notifying facilitators of the mailer of the unsolicited electronic mail as recited in claim 11, wherein the determining the facilitating party comprises determining at a protocol level which Internet protocol (IP) address sent the electronic mail message to an open relay [col. 8, lines 56-67 and col. 11, lines 18-44].

As per claim 14, Donaldson teaches the method for automatically detecting unsolicited electronic mail from the mailer and automatically notifying facilitators of the mailer of the unsolicited electronic mail as recited in claim 11, further comprising blocking electronic mail messages from the source address for a predetermined period of time [col. 8, lines 56-67 and col. 11, lines 18-44].

As per claim 15, Donaldson teaches the method for automatically detecting unsolicited electronic mail from the mailer and automatically notifying facilitators of the mailer of the unsolicited electronic mail as recited in claim 11, wherein the automatically reporting information comprises sending a report comprising information on a plurality of electronic mail messages [complaints are made to mailer's ISP col. 5, lines 1-11 and col. 15, lines 7-40].

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As per claim 16, Donaldson teaches the method for automatically detecting unsolicited electronic mail from the mailer and automatically notifying facilitators of the mailer of the unsolicited electronic mail as recited in claim 11, wherein the automatically reporting information comprises periodically sending a report to the facilitating party [complaints are made to mailer's ISP col. 5, lines 1-11 and col. 15, lines 7-40].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 10, 12 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donaldson USPN (6321267) in view of Pace et al USPN (6460050).

As per claim 10, although Donaldson shows substantial features of the claimed invention, he does not explicitly show determining a first portion in an electronic mail message.

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Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Donaldson, as evidenced by Pace et al USPN. (6460050).

In analogous art, Pace et al whose invention is about an e-mail file content classification system for determining the characteristics of the file content, disclose a system for determining portions in an electronic mail message [Col. 3, lines 8-18 and col. 4, lines 2-14].

Giving the teaching of Pace et al, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Donaldson by employing the system of Pace et al in order to identify whether a piece of e-mail is or is not Spam [Col. 3, lines 8-18].

Pace et al further teach:

calculating a first code corresponding to the first portion [generating digital Ids from portions of the body of the e-mail message with hashing algorithm [Col. 4, lines 3-14 and 53-64];

determining a second portion in the electronic mail message [Col. 4, lines 3-64 and col. 5, lines 14-17];

calculating a second code corresponding to the second portion [one or more digital identifier are generated from a particular e-mail Col. 4, lines 3-64 and col. 5, lines 14-17]; and

storing the first and second codes [abstract and Col. 4, line 53 to col. 5, line 17].

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As per claim 12, Pace et al as modified teach the method for automatically detecting unsolicited electronic mail from the mailer and automatically notifying facilitators of the mailer of the unsolicited electronic mail as recited in claim 11, wherein the determining the electronic message is unsolicited comprises:

- determining a first fingerprint indicative of the electronic mail message [Col. 3, lines 8-18 and col. 4, lines 2-14];

- receiving a second electronic mail message [Col. 4, lines 3-64 and col. 5, lines 14-17];

- determining a second fingerprint indicative of the second electronic mail message [Col. 4, lines 3-64 and col. 5, lines 14-17]; and

- comparing the first fingerprint to the second fingerprint [col. 2, lines 22-56].

As per claim 17, Pace et al teach a method for automatically processing e-mail messages from a sender, the method comprising:

- receiving a first message [col. 2, lines 22-35];

- determining a first fingerprint indicative of the first message [Col. 3, lines 8-18 and col. 4, lines 2-14];

- storing the fingerprint [abstract and Col. 4, line 53 to col. 5, line 17];

- receiving a second message [Col. 4, lines 3-64 and col. 5, lines 14-17];

- determining a second fingerprint indicative of the second message [Col. 4, lines 3-64 and col. 5, lines 14-17];

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comparing the first fingerprint to the second fingerprint
[col. 2, lines 22-56];

determining the sender is an unsolicited mailer based upon
the comparing the first fingerprint to the second fingerprint
[col. 2, lines 22-56 and col. 4, lines 53 to col. 5, line 30];
Donaldson teaches analyzing routing information of a header of
the second message [col. 15, lines 41 to col. 16, line 11 and
col. 32 lines 57 to col. 33 line32];

determining a facilitating party from the routing
information [see Donaldson, col. 14, lines 6-19 and col. 15,
lines7-40]; and automatically notifying the facilitating party
[see Donaldson, complaint is made to mailer's ISP col. 5, lines
1-11), and col. 15, lines7-40].

As per claim 18, Donaldson as modified teach the method for
automatically processing e-mail messages from a mailer as recited
in claim 17, further comprising embedding an e-mail address in
the Internet that has no legitimate purpose and is harvested by
the unsolicited mailer [col. 4, lines 50-58].

As per claim 19, Donaldson teaches the method for automatically
processing e-mail messages from mailer as recited in claim 17,
wherein the determining the facilitating party comprises
determining at a protocol level which Internet protocol (IP)
address sent the second message to an open relay [col. 8, lines
56-67 and col. 11, lines 18-44].

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As per claim 20, Donaldson teaches the method for automatically processing e-mail messages from mailer as recited in claim 17, wherein the automatically notifying the facilitating party comprises sending a report comprising information on a plurality of electronic mail messages [complaints are made to mailer's ISP col. 5, lines 1-11 and col. 15, lines 7-40].

Conclusion

2. **ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior made of record and not relied upon is considered pertinent to applicant's disclosure.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Barqadle whose telephone number is 703-305-5971. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 703-305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Yasin Barqadle



FRANTZ B. JEAN
PRIMARY EXAMINER